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In re Application of
Ekkehard NEUHAUS et al.
Application No.: 09/674,768
PCT No.: PCT/EP99/03292
Int. Filing Date: 12 May 1999
Priority Date: 13 May 1998
Attorney Docket No.: 0147-0215P
For: TRANSGENIC PLANTS WITH A
MODIFIED ACTIVITY OF A
PLASTIDIAL ADP/ATP

DECISION ON
PETITION
UNDER 37 CFR 1.48(f)(1)

This is a decision on the "Response to Notification of a Defective Response" filed 08 June 2001. Applicant requests that the DECLARATION filed 23 February 2001 signed by four of the six inventors named in the above PCT application, be accepted for the national stage under 37 C.F.R. §1.48(f)(1).

BACKGROUND

On 12 May 1998, applicant filed international application PCT/EP99/03292, which was published as WO 99/58654 naming six inventors.

On 06 November 2000, applicant submitted national stage papers under 35 U.S.C. 371. On 23 February 2001, applicant supplied the missing declaration, naming and signed by four of the six inventors.

On 28 March 2001, the Notification of Defective Oath or Declaration was sent to applicant stating that the oath or declaration does not comply with 37 C.F.R. 1.497(a) or (b) in that it does not identify all inventors.

On 27 April 2001, applicant responded by referring to 37 C.F.R. 1.48(f)(1) which

states that "If the correct inventor or inventors are not named on filing a non-provisional application under section 1.53(b) without an executed oath or declaration under section 1.63 during the pendency of the application will act to correct the earlier identification of inventorship." Applicant maintains that this procedure has been followed and that the Notification of Defective Oath or Declaration should be withdrawn.

DISCUSSION

37 C.F.R. 1.48(f)(1) refers to 37 C.F.R. 1.53(b) which applies to continuing applications under 35 U.S.C. 120, 121 or 365(c) and section 1.78(a). Applicant's national stage application is specifically designated from the transmittal letter as a filing under 35 U.S.C. 371. As a result, the PCT/EP99/03292 has the effect of a national application or the first non-provisional application which has six inventors in its Declaration.

Therefore, it is improper to refer to 37 C.F.R. 1.48(f)(1) here and applicant is required to follow the procedure set forth for correction of inventorship as established in 37 C.F.R. 1.497(d), consisting of: (1) a statement from each person being deleted as an inventor that the error in inventorship occurred without deceptive intent on his or her part; (2) an oath or declaration by the actual inventors; (3) the processing fee set forth in 1.17(i); and (4) if an assignment has been executed by any of the original inventors, the written consent of the assignee (see 47 C.F.R. 3.73(b)).

Applicant is hereby notified that the processing fee under 37 CFR 1.17(i) is \$130.00.

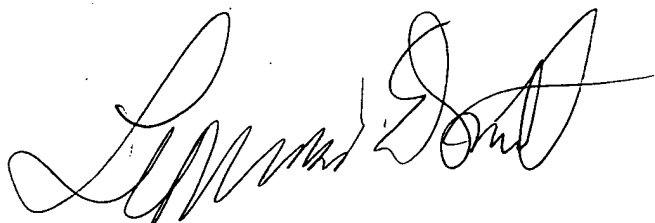
DECISION

In view of the discussion above, the petition under 37 CFR 1.48(f)(1) for correction of inventorship is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Petition Under 37 CFR 1.497 (d)."

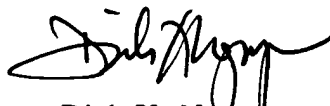
A proper response must include the items mentioned in the second paragraph of the Discussion.

Any further correspondence with respect to this letter should be addressed to the Assistant Commissioner for Patents, PCT Legal Office, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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